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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,628	01/22/2004	Jan Constant Cool	30394-1116	5051
5179	7590	08/30/2005		
PEACOCK MYERS, P.C. P O BOX 26927 ALBUQUERQUE, NM 87125-6927			EXAMINER SWEET, THOMAS	
			ART UNIT 3738	PAPER NUMBER
DATE MAILED: 08/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/762,628	Applicant(s) COOL ET AL.	
	Examiner Thomas J. Sweet	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/04 and 8/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 8/30/04 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the prior art cited is a duplicated from the 7/30/04 IDS. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the use of the term “distinguishable” is a relative term is unclear and subject interpretation rendering the scope of the claim indeterminate (i.e. distinguishable not equal distinct).

With regard to claims 2-4, the use of the term “one hand” and “other hand” is confusing and has a connotation of not positively claiming structure (i.e. sound like intended use). The Examiner suggests positively claiming structure with structure nexuses.

With regard to claims 2 and 7, the antecedent basis of “hinge” is unclear since a “pivoting coupling” is already claimed.

With regard to claim 5, is not further limiting, since it claims a one piece “front portion” and “heel” which were previously claimed as ankle hinged to one another

With regard to claim 6, claims previously claimed distinct structural members “first spring” and “coupling element” as the same member.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Elsasser (DE 309006). Elsasser discloses a foot prosthesis or orthosis (fig.1) for a member of a human body, comprising limb-forming components, which components are connected by pivoting couplings (5,6,14 etc.), and at least one first spring element (e.g. 22 or 24) whose ends are coupled with components that are distinguishable (separate?) from each other (e.g. 4), wherein a coupling element is provided spanning at least two of said pivoting couplings (e.g. 11 or 13) and further comprising a lower leg portion (1), a heel portion (2), a front portion of the foot (3) and a toe portion (4), wherein the front portion of the foot at either side ends in an ankle hinge (6) and a

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toe hinge (23), respectively, for the coupling of on the one hand the heel portion (2) and the lower leg portion (1), and on the other end the toe portion (4), and wherein the coupling element (24 and 13) spans the pivoting couplings of the front portion of the foot.

With respect to claim 3, wherein the coupling element (24 and 13) is connected on the one hand the toe portion (4) and on the other hand with a selection made from the group consisting of the lower leg portion (1) and the heel portion (2).

With respect to claim 4, wherein the coupling element (24 and 13) is connected on the one hand with the toe portion (4) and on the other hand with the lower leg portion (1).

With respect to claim 5, wherein the front portion (3) of the foot and the heel part (2) are integrated (brought together by pin 6) to form a whole (unit).

With respect to claim 6, wherein the coupling element (24 and 13) is the first spring element (24).

~~3~~ ~~18~~
Claims 1-~~6~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Collier (US 5545234). Collier discloses a foot prosthesis or orthosis (fig. 2) for a member of a human body, comprising limb-forming components, which components are connected by pivoting couplings (20 and 38), and at least one first spring element (42) whose ends are coupled with components that are distinguishable from each other (30 and 16), wherein a coupling element is provided spanning at least two of said pivoting couplings (42) and further comprising a lower leg portion (16), a heel portion (28 near 14), a front portion (28 near 42) of the foot and a toe portion (30), wherein the front portion (28) of the foot at either side ends in an ankle hinge (20) and a toe hinge (38), respectively, for the coupling of on the one hand the heel portion (28) and the lower

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leg portion (16), and on the other end the toe portion (30), and wherein the coupling element (42) spans the pivoting couplings of the front portion of the foot.

With regard to claims 3 and 4, wherein the coupling element (42) is connected on the one hand with the toe portion (30) and on the other hand with the lower leg portion (16).

With regard to claim 5, wherein the front portion of the foot and the heel part are integrated to form a whole (28).

With regard to claim 6, wherein the coupling element (42) is the first spring element (42).

With regard to claim 7, A prosthesis or orthosis according to claim wherein the heel portion (28) and the lower leg portion (16) share the ankle hinge (20) of the front portion (28) of the foot, while also being mutually coupled via a second spring element (27).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Suzuki et al. (US 6007584), Mosler et al. (US 6767370), Johnson et al. (US 6666895) and Doddroe et al. (US 6602295).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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